

REMARKS

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 16-18, 22-26, 30-34 and 36, the only claims pending and currently under examination in this application following entry of the above requested amendments.

Claim 16 has been amended to address the lack of antecedent basis for the term "said moiety." The dependency of Claims 22 and 23 has been changed from Claim 21 to Claim 16. No new matter has been introduced to the application by the above amendments. As such, the Examiner is respectfully requested to enter the above amendments.

The objection to Claims 22-23 has been addressed by the above amendment.

REJECTIONS UNDER 35 U.S.C. § 112

Claims 16-18, 22-26-30-34 and 36 were rejected under 35 U.S.C. § 112, 1st ¶ for the asserted reason that the specification is not enabling for the claimed subject matter and for the asserted reason that the claimed subject matter was not sufficiently described in the specification.

This rejection is based on the assertion by the Examiner that the specification is only enabling for the invention where the **drug moiety is one of FK506, cyclosporin and rapamycin**. Specifically, the Examiner states that the specification is only enabling for a "bifunctional molecule of less than about 5000 daltons consisting of a drug moiety where the drug is selected from the group consisting of FK506, cyclosporin, and rapamycin..."

It is respectfully submitted that, in making these rejections, the Examiner has apparently misunderstood the invention as described in the specification and presently claimed. Specifically, FK506, cyclosporin, and rapamycin are not the drug moieties in the bifunctional molecules employed in the present invention, but instead are exemplary biodistribution or "Z" moieties. See e.g., page 21, lines 3 to 5 of the specification where it is stated:

"Representative ligands capable of serving as the Z moiety of the bifunctional molecule include ligands for intracellular proteins, such as: peptidyl-prolyl isomerase ligands, e.g. FK506, rapamycin, cyclosporin A and the like..."

In view of this misunderstanding by the Examiner of the claimed and described invention, it is respectfully submitted that the rationale for the rejection provided by the Examiner is inapplicable to the claimed invention and therefore that this rejection may be withdrawn.

Furthermore, it is respectfully submitted that the claimed invention is adequately enabled and described by the specification such that the claims satisfy the requirements of 35 U.S.C. § 112, 1st ¶.

The bifunctional molecules employed in the subject methods are extensively described in the specification beginning at page 4 of the specification. This extensive description includes a generic description of these molecules, a description of these molecules in terms of formulas, an extensive description of each of the component parts of the molecules, e.g., drug moieties (see pages 6 to 16), targeting moieties (see pages 16 to 21) and linking moieties (see pages 22 to 23) as well as a detailed description of how to make these targeted bifunctional molecules (see pages 24 to 28). As such, the bifunctional molecules are fully described in the specification both in terms of

component parts and in how to make them.

Furthermore, the specification teaches beginning at page 29 how to use the bifunctional molecules and therefore how to practice the claimed methods.

Accordingly, one of skill in the art could practice the full scope of the claimed invention without undue experimentation.

In addition, the invention is described sufficiently in the specification, as evidenced by the above-cited detailed descriptions, such that one of skill in the art would know that the Applicants are in possession of the claimed genus.

As such, the claims are fully enabled and described in the specification and this rejection may be withdrawn.

Finally, Claims 16 - 18 were rejected under 35 U.S.C. § 112, 2nd ¶. In view of the above amendment to Claim 16, this rejection may be withdrawn.

PRIOR ART REJECTION

Claims 16-18, 22-26, 30-34 and 36 were rejected under 35 U.S.C. §103 (a) over Pinchon in view of Breisewitz, U.S. Patent No. 5,830,462 and WO 95/10302.

Section 102(a) reads: "A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent."

A printed publication cannot stand as a reference under §102(a), and therefore be used in a rejection under §103(a) in combination with other references, unless it describes the work of another. A prior patent or printed publication is not "prior art" if

the disclosure is that of the Applicants' own work, until the end of the one year period afforded under §102(b), during which time an inventor is allowed to perfect, develop and apply for a patent on his invention and publish descriptions of it if he wishes.

Since the Briesewitz publication in this case occurred less than one year before the priority date of the Applicants' application, the disclosure comes within the scope of §102(a) only if the description is not of the Applicants' own work. Authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Thus, co-authors may not be presumed to be coinventors merely from the fact of co-authorship (see *In re Katz*, 215 USPQ at 18).

Applicants have provided with this response a Declaration made under 35 U.S.C. §1.132 describing the contributions of the co author Gregory Ray in the cited Briesewitz et al. paper. As stated in the declaration, Gregory Ray worked at the direction of the inventors of the presently named application.

In view of the above remarks and attached Declaration, the Applicants respectfully submit that the presently claimed invention is not obvious over Pinchon in view of Breisewitz, U.S. Patent No. 5,830,462 and WO 95/10302 because Breisewitz cannot be used as a reference against the present application since it does not qualify as prior art to the present application under §102(a) or any other part of §102.

As such, the Applicants respectfully request withdrawal of this rejection of Claims 16-18, 22-26, 30-34 and 36 under 35 U.S.C. §103 (a) over Pinchon in view of Breisewitz, U.S. Patent No. 5,830,462 and WO 95/10302.

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

Finally, the Examiner stated at the end of the office action that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, this action is made Final."

The new rejections presented by the Examiner included new §112, first paragraph rejections that were not before raised in the prior office action. The amendments made in the Applicant's last response did not broaden the claimed invention. As such, the Examiner could have raised the §112, first paragraph rejections in the first office action but did not do so. Furthermore, the new prior art rejection under 103 based on Briesewitz could also have been raised against the previously pending claims, but was not. Accordingly, it is respectfully submitted that the Applicants' amendments did not necessitate the new grounds of rejection. Therefore, the Examiner is respectfully requested to withdraw the finality of the last office action.

CONCLUSION

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,

Date: 10-2-03

By: 
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enc:

Declaration

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CERTIFICATE OF MAILING

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Declaration Under 1.132

Address to:
Assistant Commissioner for Patents
Washington, D.C. 20231

Attorney Docket
Confirmation No.

STAN-131

First Named Inventor

Briesewitz

Application Number

09/716,842

Filing Date

November 17, 2000

Group Art Unit

1651

Examiner Name

Phuong N Huynh

Title

Bifunctional Molecules
Having Modulated
Pharmacokinetic
Properties and
Therapies Based
Thereon

Dear Sir:

I, Dr. Thomas Wandless, do hereby declare as follows:

I am a co-inventor of the above captioned patent application.

I am a co-author of the research publication: Briesewitz et al., Proc. Nat'l Acad. Sci. USA (March 1999) 96:1953-1958.

The presently pending claims have been rejected under 35 U.S.C. 103(a) as made obvious by the publication of Briesewitz *et al.* (1999), in combination with supplemental references.

The cited published article was a description, in part, of the invention conceived by myself, and as such, is not a publication by another. The article lists as co-authors Roger Briesewitz and Gerald Crabtree, who are named as co-inventors, and Gregory Ray, who is not named as a co-inventor.

As set forth by the court in *In re Katz*, 215 U.S.P.Q. 14; and MPEP §715.01(c), authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Thus, coauthors may not be presumed to be coinventors merely from the fact of coauthorship.

The conceptualization of these experiments and the formulation of the invention were the work of myself and my coinventors, Roger Briesewitz and Gerald Crabtree.

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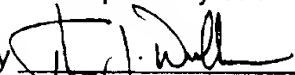
USSN: 09/716,841

Gregory Ray was operating under the direction of myself and/or my listed coinventors and therefore did not make an inventive contribution to the subject matter claimed in the present application.

I hereby declare that all statements made herein of my own knowledge are true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 25 Sept 2003

Respectfully submitted,

By 
Thomas Wandless, Ph.D.